



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Atty. Dkt.: ICB0063
)
Philippe JACOT) Confirmation No. 4877
)
Serial No. 09/581,916) Group Art Unit: 3624
)
Filed: June 19, 2000)
)
For: PROCESS ENABLING FINANCIAL) Examiner: Daniel S. FELTON
TRANSACTIONS, SYSTEM THEREOF)
AND ELECTRONIC PURSE) Date: October 22, 2004

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313

Sir:

Applicants respectfully submit this appeal brief under 37 C.F.R. § 1.192 in the above-identified application. The present appeal brief addresses and responds to all outstanding issues set forth in the final office action dated January 27, 2004.

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I. Real Party in Interest

The real party in interest is Philippe Jacot.

II. Related Appeals and Interferences

There are no related appeals or interferences with respect to the above captioned application.

III. Status of Claims

Claims 1-28 have been cancelled without prejudice. Claims 29-47 are pending, have been finally rejected, and are under appeal.

IV. Status of Amendments

Amendment (D) After Final was filed on May 27, 2004 and has **not** been entered. Amendment (D), *inter alia*, amends claim 40 to obviate a §112 rejection that was raised for the first time in the final office action dated January 27, 2004.

V. Summary of Claimed Subject Matter

The present invention relates to a method and apparatus for performing secure electronic financial transactions, namely transactions involving an electronic purse in connection with a financial institute and with a cashing device of a seller, with a third connection between the financial institute and the cashing device.

Claim 29 is the only independent claim.

One advantage of the electronic purse of the present invention is that fraudulent use of a stolen device can be easily curtailed. One way this is accomplished is through the use of an identification code, as recited in claim 29, that is particular to the purse in order to precisely identify the purse (p. 3, lines 9-11). This code is particularly useful together with real-time communication (p. 1 line 30 to p. 2 line 5).

Another noteworthy feature of the present invention, corresponding to claims 40-46, or all claims if Amendment (D) is entered, is that the invention requires no preset spending limit, as is characteristic of debit and credit cards, because communications regarding available funds occur in real time (p. 1, lines 8-22).

Moreover, one embodiment of the invention, corresponding to claim 46, comprises an electronic beacon, such as a GPS beacon, to facilitate finding an electronic purse that is stolen or lost (p. 7, lines 1-8).

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are on appeal:

- (I) Claims 40-46 stand rejected under 35 U.S.C. §112 as indefinite.
- (II) Claims 29-46 stand rejected under 35 U.S.C. §103(a) as unpatentable over Gutman et al. (U.S. Patent 5,221,838) [hereinafter "Gutman"] in view of Vazvan (WIPO publication WO 97/45814) [hereinafter "Vazvan"].
- (III) Claim 47 stands rejected under 35 U.S.C. §103(a) as unpatentable Gutman in view of Vazvan and in further view of Kawan (U.S. Patent 5,796,832) [hereinafter "Kawan"].

VII. Arguments***(I) Rejection of claims 40-46 under 35 U.S.C. §112 as indefinite***

In the final Office Action dated June 24, 2003, the Examiner made for the first time a rejection on the basis of 35 U.S.C. §112, second paragraph, of claim 40 and its dependent claims for being indefinite, namely for reciting “almost” in the phrase “real time or almost real time.” The Amendment (D) After Final, filed on May 27, 2004 and as yet not considered by the Examiner, would obviate this issue by removing the objectionable term.

In a telephone conversation on September 23, 2004, the Examiner expressed agreement that removal of the phrase “or almost real time” would obviate the rejection. Entry of the Amendment After Final would thus remove this issue from appeal. Therefore, in accordance with M.P.E.P. § 1207 and 37 C.F.R. §1.116, Applicants respectfully request entry of Amendment (D) filed on May 27, 2004, and reconsideration and withdrawal of the rejection of claims 40-46 under §112.

(II) Rejection of claims 29-46 under 35 U.S.C. §103(a) as unpatentable over Gutman in view of Vazvan

The Examiner has asserted that Gutman and Vazvan together teach all of the elements of claims 29-46. This assertion is incorrect for at least the following reasons.

First, the references fail to teach that “an identification code from said electronic purse is transmitted when each of said connections is set” as disclosed in base claim 29.

As admitted by the examiner, Gutman fails to teach this limitation (Office Action dated June 24, 2003, page 3, lines 13-14). The specification defines an identification code of the present invention as one comprising a code particular to the purse (present specification, p. 3, lines 9-11). The examiner improperly asserts that Vazvan discloses that “an identification code from said electronic purse is transmitted when each of said connections is set,” and that in combination with Gutman, the elements of claim 29 are taught. Vazvan teaches a wireless secure payment system, including “payee’s details such as a contact code or number, account code or number, and bill” (Vazvan, p. 2, lines 30-32; see also p. 3, lines 3-7 and 26-27). Neither Gutman nor Vazvan teaches transmission of an identification code from said electronic purse, which is particular to the purse, as disclosed in the present invention.

Second, none of the references of record teach, or even suggest, “a transmission of a spending authorization for a specific amount of money is carried out when the third connection is set between the financial institute and the cashing device, to prevent any non-authorized spending with the electronic purse” as recited in claim 29 (emphasis added). Formation of the three connections provides for a thoroughly secure transaction (specification p. 5, lines 1-3), particularly since each connection as claimed includes the identification code. The lack of this claimed limitation in the prior art further demonstrates the untenability of the rejection.

For all of the above reasons, Applicants respectfully traverse the rejection of claims 29 and claims 30-46, which directly or indirectly depend on claim 29.

Amendment (D) After Final, filed on May 27, 2004, would additionally limit claim 29 so that the identification code from the electronic purse “is transmitted in real

time when each of said connections is set.” While Applicants assert that claim 29 is patentable without this limitation, in the event that Amendment (D) is entered, Applicants assert that the change would still further distinguish the claim from the prior art. None of the references of record teach connections that “transmit in real time” as disclosed in the claim as amended. Such real time transmission provides the advantages of not requiring a preset spending limit and supplies a extra measure of security. This issue is further discussed under subheading (A) immediately below.

(A) Separate patentability of claims 40-46

Among claims 29-46 rejected under 35 U.S.C. §103(a) as unpatentable over Gutman in view of Vazvan, claims 40-46 are separately patentable over claims 29-39. By virtue of including all of the limitations of claim 29, claims 40-46 are patentable for the reasons discussed above. For the reasons discussed immediately below, claims 40-46 are separately patentable.

Claim 40, the base claim for claims 40-46, recites a limitation not present in the cited references, namely that “said devices for establishing a first and a second connections are able to transmit in real time or almost real time an identification code from said electronic purse to said financial institute and said cashing device of the seller.” The proposed Amendment (D) would removed the words “or almost real time” to obviate the §112 rejection.

The Examiner asserts that Gutman teaches that “said devices are able to transmit in real time an identification code from said electronic purse to said cashing device of the seller (see Gutman, fig. 5A-E, col. 12, ll. 33+)” (Office Action dated January 27, 2004,

page 8, lines 13-15). As a first matter, even if Gutman taught the matter asserted by the Examiner, there is no mention of real-time transmission between the purse and the financial institute, as disclosed in claim 40, therefore there is no *prima facie* case of obviousness. As a second matter, Gutman does not teach, or even suggest, that the connections occur “in real time” (or “almost in real time”), so again there is no *prima facie* case of obviousness. On the contrary, Gutman teaches that away from real time transmission with a periodic updating scheme to update the balance in the wallet (Gutman, col. 12, lines 50-58). The present invention would have funds added to the account become immediately available, whereas Gutman would impose a delay until the wallet is updated. Also, Gutman’s scheme does not accomplish the goals of real-time transmission as described in the specification, namely the elimination of a requirement for a preset spending limit, as is characteristic of debit and credit cards, because communications regarding available funds lags behind actuality (Specification, p. 1, lines 8-22). For all of these reasons, claims 40-46 stand separately patentable.

(B) Further separate patentability of claim 46

Among claims 29-46 rejected under 35 U.S.C. §103(a) as unpatentable over Gutman in view of Vazvan, claim 46 is separately patentable over claims 29-45 and also over claims 40-45. By virtue of including all of the limitations of claim 29, claim 46 is patentable for the reasons discussed above under heading (II). Also, by virtue of including all of the limitations of claim 40, claim 46 is patentable for the reasons discussed above under subheading (II)(A). For the reasons discussed immediately below, claim 46 is separately patentable.

Claim 46 recites a limitation, “including a beacon means allowing localization of said purse,” which is not described in the cited references. The Examiner’s statements regarding patentability of claim 46 are incomprehensible: the Examiner twice states that “Gutman fails to disclose [sic] wherein characterized in that it includes further beacon means allowing to localize it (see Gutman col. 4, ll. 44+)” (Office Action dated June 24, 2003, page 8, lines 18-19, and Office Action dated January 27, 2004, page 10, lines 1-2).

The Examiner’s statements regarding claim 46 can only be interpreted as asserting one of two situations: (1) Gutman fails to teach the limitation, or (2) the limitation is taught by Gutman. In situation (1), there is no *prima facie* case of unpatentability and the claim is allowable. In situation (2), Gutman in fact fails to teach, or even suggest, “a beacon means allowing localization.” The section of Gutman cited by the Examiner (col. 4, lines 44-54) merely teaches various “wireless communications means” without any localization information whatsoever. Contrastingly, the “beacon allowing localization” in present claim 46 is described in the specification (page 7, line 2) as an “Argos or GPS type.” Because the references fail to teach “a beacon means allowing localization” as recited in claim 46, claim 46 stands patentable.

(III) Rejection of claim 47 under 35 U.S.C. §103(a) as unpatentable over Gutman in view of Vazvan and in further view of Kawan

Claim 47 is patentable for the reasons discussed at heading (I) above because it depends indirectly on base claim 29, and for the reasons discussed at subheading (II)(A)

above because it depends on claim 40. Moreover, the separate rejection of claim 47 is also untenable.

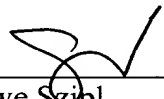
Kawan teaches a financial information and transaction system including a biometric identification file (222) and an encrypted digital signature file (224). Neither Kawan nor the other cited references teach any security feature which “control[s] the restitution of a remaining amount” of funds in the purse, as disclosed in claim 47 as amended. As recited in the specification (p. 7, lines 9-14), this claimed feature permits an owner to deactivate an electronic purse that is lost or stolen. Because the limitation is absent from the cited references, claim 47 stands separately patentable.

VIII. Conclusion

For the reasons above, claims 40-46 meet the requirements of 35 U.S.C. §112, claims 29-46 are patentable over Gutman in view of Vazvan, claims 40-46 are separately patentable, claim 46 is further separately patentable and claim 47 is separately patentable over Gutman, Vazvan and Kawan. Reversal and withdrawal of the outstanding rejections is respectfully requested.

Respectfully submitted,

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Claims Appendix

The following is a listing of the claims in the present application as they stand before entry of Amendment (D) filed on May 27, 2004, which has not been entered by the Examiner, but which would obviate Issue 1, namely rejection of claim 40 and its dependent claims as unpatentable under §112.

Claims 1-28 are cancelled.

29. A process enabling financial transactions between a purchaser, at least one seller and at least one financial institute, wherein:

- a first connection is set between an electronic purse carried by the purchaser and a financial institute from which the purchaser is related to,

- at least a second connection is set between said electronic purse carried by the purchaser and a cashing device owned by the seller, and

- for said second connection or any other second connection, a third connection is set between said cashing device owned by a seller and the financial institute from which the purchaser is related to, wherein

- an identification code from said electronic purse is transmitted when each of said connections is set, and

- a transmission of a spending authorization for a specific amount of money is carried out when the third connection is set between the financial institute and the cashing device, to prevent any non-authorized spending with the electronic purse.

30. A process according to claim 29, wherein the third connection is set through a second financial institute from which the seller is related to.

31. A process according to claim 29, wherein said first connection is of radio-electric type on at least a portion of its path, and wherein the third connection transits on the telephone network for at least a portion of its path.

32. A process according to claim 29, wherein said first connection is carried out by a connection via a ground relay and a telephone network, or by a connection between said electronic purse and a communication satellite which transmits a signal via the relay or directly to said institute.

33. A process according to claim 29, wherein the second connection is realised by a connecting cable which links a connector of the electronic purse to a connector of the cashing device or by a card including writable memory means, or is of radio-electric or infrared type.

34. A process according to claim 29, wherein the first connection includes in particular the steps of:

- transmission of a PIN code,
- transmission of a spending authorisation request for a specific amount of money,

and

- transmission of a spending authorisation of the specific amount of money,
and/or
- transmission of the specific amount in electronic money.

35. A process according to claim 29, wherein the second connection includes in particular the steps of:

- transmission of the spending authorisation of a specific amount of money,
and/or
- transmission of the specific amount in electronic money.

36. A process according to claim 29, wherein the third connection includes in particular the steps of:

- transmission of an identification code from the cashing device, and/or
- transmission of the specific amount in electronic money.

37. A processing according to claim 29, wherein the first and/or second connection includes in particular a step of:

- transmission of a recognition code of a parameter suitable for the purchaser, said purchaser introducing said parameter by a keyboard of the electronic purse and/or by a recording device of said parameter, which includes a sensitive zone on which said purchaser puts a fingerprint of one of his fingers in order to be compared with a fingerprint stored in a memory circuit of said electronic purse, said recognition code

being separately transmitted or combined with the identification code from the electronic purse.

38. A system to implement the process according to claim 29, the system including the following means:

- a first device for establishing a first connection between an electronic purse carried by the buyer and a financial institute from which the buyer is related to,
- a second device for establishing a second connection between the electronic purse carried by the buyer and a cashing device owned by a seller, and
- a third device for establishing a third connection between said cashing device owned by a seller and the financial institute from which the buyer is related to, wherein
- said first, second and third devices for establishing a connection are able to transmit an identification code from the electronic purse, and
- at least said third device for establishing said third connection is able to transmit a spending authorization for a specific amount of money between the financial institute and the cashing device, to prevent any non-authorized spending with said electronic purse.

39. A system according to claim 38, wherein said third device for establishing a third connection includes connecting means between the cashing device owned by a seller and a financial institute from which the seller is related to, and other connection means between said financial institute from which the seller is related to and the financial institute from which the buyer is related to.

40. An electronic purse being part of a system according to claim 38, and for executing a process enabling financial transactions between a purchaser, at least one seller and at least one financial institute according to claim 29, said purse including in particular:

- a first device for establishing a first connection with a financial institute, and
- a second device for establishing a second connection with a cashing device,

wherein

- said devices for establishing a first and a second connections are able to transmit in real time or almost real time an identification code from said electronic purse to said financial institute and said cashing device of the seller.

41. An electronic purse according to claim 40, wherein said first device for establishing a first connection includes in particular transmitting and receiving means of radio-electric signals or mobile phone means.

42. An electronic purse according to claim 40, wherein said second device for establishing a second connection includes in particular a device for introducing a chip card and a device for writing in a writable memory of said chip card, and/or transmitting and receiving means of radio-electric or infrared type.

43. An electronic purse according to claim 40, wherein said second device for establishing a second connection includes in particular a connector for a connection by cable with said cashing device.

44. An electronic purse according to claim 40, wherein it is controlled by a computer program able to carry out a financial transaction according to any currency.

45. An electronic purse according to claim 40, wherein it includes further computer means and bar code reading means.

46. An electronic purse according to claim 40, further including a beacon means allowing localization of said purse.

47. An electronic purse according to claim 40, wherein it includes further a separated remote control able to send a signal toward said electronic purse in order to deactivate said purse and to control restitution of a remaining amount, and/or a sensitive zone able to record a parameter suitable for the user such as a fingerprint or a signature in order to be compared with one fingerprint or signature stored in a memory circuit of said electronic purse.